REMARKS

The outstanding issues in the instant application are as follows:

- Claims 1-34 are rejected under 35 U.S.C. § 103(a).

Applicants hereby traverse the outstanding objections and rejections, and request reconsideration and withdrawal in light of the remarks contained herein. Claims 1-34 are pending in the present application. No amendment to the claims has been made.

REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 1-34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Application No. 2002/0177448 to Moran (hereinafter *Moran*) in view of U.S. Pat. No. 6,757,521 to Ying (hereinafter *Ying*). Applicants hereby traverse the outstanding rejections and request reconsideration and withdrawal in light of the remarks contained herein.

To establish a *prima facie* case of obviousness, three basic criteria must be met. *See* M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. To meet this first requirement the Examiner must explain why one skilled in the art would look to a particular set of references and why one skilled in the art would be motivated to make the combination suggested by the examiner. *In re Rouffett*, 149 F.3d 1350, 1357 (Fed. Cir. 1998); *in re Wood*, 599 F.2d 1032, 1036 (CCPA 1979). Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Applicants respectfully assert that the rejections of record do not meet the foregoing requirements. Accordingly, Applicants traverse the 35 U.S.C § 103 rejections of record.

A. *Claim 1*

The Examiner has rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over *Moran* in view of *Ying*. Applicants respectfully traverse this rejection.

In the office action, the Examiner acknowledges that *Moran* is silent as to several elements of claim 1 including the requirement that the smart probe determines a set of conditions for each one prior to the measuring. The Examiner next states that *Ying* teaches a method and system for locating and assisting remote diagnostic and analysis of a control networks. However, the Examiner fails to point out where *Ying* teaches that the remote diagnostic units determine a set of conditions for each measurement request prior to measurement. In fact, *Ying* contains no such teaching. Thus, both references, either alone or in combination, fail to teach or suggest this element of the claims. This failure to teach all the limitations or elements of the claims precludes a finding of unpatentability under 35 U.S.C. §103(a). Applicants, therefore, respectfully request that the rejection of record be withdrawn.

B. *Claims 2 through 12*

Claims 2 through 12 depend from claim 1 and thus include all the elements of claim 1. 37 C.F.R. § 1.75(c) As demonstrated in Section A above, the *Moran* and *Ying* references fail to teach all the elements of claim 1. Similarly, based on their dependence from claim 1, the references also fail to teach all the elements of claims 2 through 12. Again, the failure to teach or suggest all the elements of the claim precludes a finding of obviousness. Applicants, therefore, also respectfully request that the rejection of claims 2 through 12 be withdrawn.

C. *Claims 13 and 14*

The Examiner has rejected claims 13 and 14 under 35 U.S.C. § 103(a) as being unpatentable over *Moran* in view of *Ying*. Applicants respectfully traverse this rejection.

Claim 13 requires the limitation "determining at said plurality of smart probes a set of tasks for completing said experiment." Claim 24 contains a similar limitation which reads "means for determining at said plurality of smart probes a set of actions for completing said experiment." Applicants respectfully submit that neither *Moran* nor *Ying* either alone or in combination teach or suggest these elements. Absence of such teaching precludes a finding of unpatentability under 35 U.S.C. § 103(a).

In the office action, the Examiner acknowledged that, among other elements, *Moran* does not teach "determining at said probes a set of tasks for completing said experiment." Thus, *Moran* alone does not render these claims unpatentable.

Ying is similarly devoid of a teaching that the tasks for completing the experiment are determined at the probes. In fact, the *Ying* reference teaches the opposite. For example, *Ying* teaches that the remote diagnostic system receives an instruction, "carries it out and awaits the next instruction." Col. 18, ln 59 through Col. 19, ln 10. Thus, the diagnostic system does not determine the steps to employ but waits for step-by-step instructions from the central controller. *Id.* This is the exact opposite of what is required by the claims where the necessary steps are determined ***at the probe***. Therefore, *Ying* does not teach the limitations that the Examiner admits are missing from *Moran*.

Thus, given the Examiner's admission that *Moran* is silent about determining a set of tests for completing the experiment at the probe(s) and *Ying*'s teaching a completely different process, the rejection under 35 U.S.C. § 103(a) cannot be maintained. Applicants respectfully request that the Examiner withdraw this rejection.

D. *Claims 14 – 23 and 25 – 34*

The Examiner has rejected claims 14 – 23 and 25 – 34 as being unpatentable under 35 U.S.C. § 103(a) over *Moran* in view of *Ying*. Applicants respectfully traverse this rejection.

Claims 14 – 23 depend from claim 13, and claims 25 – 34 depend from claim 24. As such, each of the dependent claims includes the limitations recited in their related independent claims, as well as the additional limitations recited in those dependent claims, 37 C.F.R. § 1.75(c)

As discussed above, *Moran* and *Ying*, both alone and in combination, fail to teach at least one element of claims 13 and 24. Thus, they also fail to teach all the elements of dependent claims 14 – 23 and 25 – 34. This failure to teach all of the elements of the claims precludes a finding of unpatentability under 35 U.S.C. § 103(a). Applicants, therefore, respectfully request that the Examiner withdraw this rejection.

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-1078, under Order No. 10030565-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV568257856US, in an envelope addressed to: MS Amendment, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date of Deposit: June 20, 2006

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Respectfully submitted,

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